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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/678,653

10/06/2003

Frank Bonadio

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22852

7590

09/26/2008

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EXAMINER

RAMANA, ANURADHA

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

09/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/678,653	Applicant(s) BONADIO ET AL.	
	Examiner Anu Ramana	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 135-186 is/are pending in the application.
- 4a) Of the above claim(s) 142, 143, 150, 158, 159, 166, 174, 175 and 182-186 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 135-141, 144-149, 151-157, 160-165, 167-173 and 176-181 is/are rejected.
- 7) ☒ Claim(s) 145, 161 and 177 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/6/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413) |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) ☒ Information Disclosure Statement(s) (PTO/SB/08) | 5) ☐ Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/30/08</u> . | 6) ☐ Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 140-141, 146-149, 156-157, 162-165, 172-173 and 178-181 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 140, the recitation, "a valve coupled to the anchoring frame" seems to imply a separate valve. However, Applicants' disclosure shows the retracting member along with the securing and anchoring frames, behaving as a valve.

Appropriate correction of claim terminology is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 135-141, 144, 151-157, 160, 167-171 and 176 are rejected under 35 U.S.C. 102(e) as being anticipated by de la Torre et al. (US 5,672,168).

de la Torre et al. disclose a wound retractor including: an anchoring frame (408, 410); a retracting member 392; and a securing frame wherein the retracting member and the securing frame are frictionally engaged and movable relative to one another

and a seal formed by the parts of the anchoring frame moved relative to one another (382, 384) (Figs. 31-32, col. 15, lines 9-67, col. 16 and col. 17, lines 1-38).

Claims 135-141, 144, 151-157, 160, 167-173 and 176 are rejected under 35 U.S.C. 102(e) as being anticipated by Beane et al. (US 5,906,577).

Beane et al. disclose a wound retractor including: an anchoring frame (68, 69); a retracting member 66; a securing frame 64 wherein the sleeve and the securing frame are movable relative to one another; and an iris valve 76 attached to the anchoring frame (68, 69) (Figs. 1, 2D-2E and 6A-6B, col. 5, lines 43-67 and cols. 6-13).

Response to Arguments

Applicant's arguments filed on April 30, 2008 have been fully considered.

The Terminal Disclaimer filed on April 30, 2008 has been approved. Accordingly, the double patenting rejections made in the previous office action have been overcome.

Regarding claims 183-186, the Examiner notes that these claims are directed to method claims, a non-elected invention. The Examiner will consider rejoinder, if necessary, once the instant application is placed in condition for allowance.

Applicant's arguments with respect to the rejections under 35 USC 112 first paragraph are not persuasive for the following reason.

The claim language seems to imply a separate valve. However, Applicant's elected species shows the retracting member acting as a valve. Accordingly, this rejection is deemed proper.

Applicant's arguments with respect to de La Torre are not persuasive. Contrary to Applicant's arguments, sleeve 392 is a "retracting member" since it pushes away body tissue. Applicant's arguments with respect to Beane et al. are not persuasive for the following reason because the anchoring frame, i.e., collars (68,69) is located proximal of the opening (see Fig. 2E) and the securing frame 64 is located distal of the opening (see Fig. 2E). It is noted, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate

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the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Allowable Subject Matter

Claims 145, 161 and 177 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
September 15, 2008

/Anu Ramana/
Primary Examiner, Art Unit 3733